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TRANSMITTAL OF APPEAL BRIEF (IN TRIPLICATE)		Docket No. (Optional): 560301-1420								
<p>I hereby certify that this correspondence is being facsimile transmitted to the U.S. Patent and Trademark Office to: Thomas M. Sembe at facsimile number (703) 872-9319 on February 9, 2004.</p> <p style="text-align: center;"><u>February 9, 2004</u></p> <p style="text-align: center;"><u>Belinda K. Weiss</u></p> <p>Signature - Belinda K. Weiss</p>		<p>In re Application of Layne et al.</p> <table border="1" style="width: 100%; border-collapse: collapse;"><tr><td style="width: 50%; padding: 2px;">Application Number 09/917,205</td><td style="width: 50%; padding: 2px;">Filed 07/30/2001</td></tr><tr><td colspan="2" style="padding: 2px;">For Assembly for a Wedge Base Track Lamp Holder</td></tr><tr><td style="padding: 2px;">Group Art Unit 2875</td><td style="padding: 2px;">Examiner Sember, Thomas M.</td></tr><tr><td colspan="2" style="padding: 2px;">Confirmation No.: 8321</td></tr></table>	Application Number 09/917,205	Filed 07/30/2001	For Assembly for a Wedge Base Track Lamp Holder		Group Art Unit 2875	Examiner Sember, Thomas M.	Confirmation No.: 8321	
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<p>Transmitted herewith in triplicate is the Appeal Brief in this application with respect to the Notice of Appeal filed on 11/07/2003</p> <p>The fee for this Appeal Brief is (37 CFR 1.17(c)) \$ 330.00</p> <p style="text-align: center;">(complete (a) or (b) as applicable)</p> <p>The proceedings herein are for a patent application and the provisions of 37 CFR 1.17(a)-(d) apply.</p> <p><input checked="" type="checkbox"/> (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d) for the total number of months checked below:</p> <table style="width: 100%;"><tr><td><input checked="" type="checkbox"/> One month (37 CFR 1.17(a)(1))</td><td style="text-align: right;">\$ 110.00</td></tr><tr><td><input type="checkbox"/> Two months (37 CFR 1.17(a)(2))</td><td style="text-align: right;">\$ 420.00</td></tr><tr><td><input type="checkbox"/> Three months (37 CFR 1.17(a)(3))</td><td style="text-align: right;">\$ 950.00</td></tr><tr><td><input type="checkbox"/> Four months (37 CFR 1.17(a)(4))</td><td style="text-align: right;">\$ 1,480.00</td></tr></table> <p><input type="checkbox"/> The extension fee has already been filed in this application.</p> <p><input type="checkbox"/> (b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that the applicant has inadvertently overlooked the need for a petition and fee for extension of time.</p> <p>Method of Payment:</p> <p><input checked="" type="checkbox"/> Payment is enclosed as follows:</p> <p><input type="checkbox"/> A check in the amount of \$ _____ enclosed.</p> <p><input checked="" type="checkbox"/> Payment by credit card. Form PTO-2038 is attached in the amount of \$440.00</p> <p><input checked="" type="checkbox"/> The Commissioner is authorized to charge _____ to a Deposit Account</p> <p><input checked="" type="checkbox"/> The Commissioner is hereby authorized to charge any deficiencies in fees, or credit any overpayment to Deposit Account No. 20-0778. A duplicate copy is enclosed.</p> <p>Warning: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.</p> <div style="display: flex; justify-content: space-between; margin-top: 20px;"><div style="text-align: center;"><p><u>2/9/2004</u></p><p>Date</p></div><div style="text-align: center;"><p><u>Christopher D. Guinn</u></p><p>Christopher D. Guinn - Reg. No. 54,142</p></div></div>			<input checked="" type="checkbox"/> One month (37 CFR 1.17(a)(1))	\$ 110.00	<input type="checkbox"/> Two months (37 CFR 1.17(a)(2))	\$ 420.00	<input type="checkbox"/> Three months (37 CFR 1.17(a)(3))	\$ 950.00	<input type="checkbox"/> Four months (37 CFR 1.17(a)(4))	\$ 1,480.00
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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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Appln. No.: 09/917,205

Art Unit: 2875

Appellants: Layne *et al.*

Examiner: Sember, Thomas M.

Filed: July 30, 2001

Confirmation No.: 8321

Title: ASSEMBLY FOR A WEDGE
BASE TRACK LAMP HOLDER

Docket No.: 560301-1420

Mail Stop – Appeal Brief
Honorable Commissioner of Patents and Trademarks
P.O. Box 1450
Alexandria, VA 22313-1450**APPEAL BRIEF UNDER 37 C.F.R. §1.192**

Sir:

This Appeal Brief, filed in accordance with 37 C.F.R. §1.192, respectfully appeals from the decision of Examiner Thomas Sember in the Office Action mailed August 8, 2003 (Paper No. 12), rejecting claims 27-42 in the present application and making the rejection FINAL. Since February 8, 2004 falls on a Sunday, this paper is being filed on the next business day with a petition for a one month extension under 37 CFR 1.136(a).

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I. REAL PARTY IN INTEREST

The real party in interest of the instant application is Cooper Technologies Company, a Texas corporation, having its principal place of business in Houston, Texas.

II. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

III. STATUS OF THE CLAIMS

Claims 27-45 are pending in the application. Claims 43-45 have been allowed. The FINAL Office Action rejects claims 27 and 31 under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent No. 4,676,567 to *Mouchi* ("*Mouchi*"). The FINAL Office Action also rejects claims 27-42 under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent No. 4,190,309 to *Glass* ("*Glass*"). Furthermore, the FINAL Office Action rejects claims 27-33 and 35-41 under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent No. 6,203,339 to *Nieminen* ("*Nieminen*"). Therefore, claims 27-42 are under appeal.

IV. STATUS OF AMENDMENTS

No amendment has been submitted after the FINAL Office Action, and all claim amendments submitted prior to that have been entered.

V. SUMMARY OF THE INVENTION

The present invention is directed to a lamp holder assembly (FIGs. 1 and 28 – 30, 108) for a track lighting system (FIG. 1, 100). The lamp holder assembly includes a base (FIG. 30, 818) having a first lamp channel (FIG. 30, 820) for holding a lamp. The lamp holder assembly also includes electrically conductive contact members (FIG. 30, 816) and a retention piece (FIG. 30, 814). The electrically conductive contact members have a first portion (FIG. 30, contact fingers 868) and a second portion (FIG. 30, tongue 860). The first portion of the

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electrically conductive contact members are arranged in the first lamp channel for contacting the lamp. The second portion of the electrically conductive contact members are for contacting an electrical conductor (FIG. 2A, 125) in the track frame (FIG. 2A, 112). The lamp holder assembly further includes a retention piece (FIG. 30, 814) for securing the electrically conductive contact members within the base.

FIGS. 28-32 illustrate various views of an embodiment of a lamp holder assembly. The lamp holder 108 includes a holder 810, one or two reflectors 812, a retention plug 814, and electrical contact clips 816. For example, FIG. 28 illustrates the lamp holder 108 with two reflectors 812 and FIG. 29 illustrates the lamp holder with one reflector 812.

Referring to FIG. 30, the holder 810 includes a body 818, a shaped channel 820, an open channel 822, a stem 824, a stop disk 826, and a rotation disk 828. In the wedge base lamp holder 108 with one reflector 812, the shaped channel 820 extends through one end 832 of the body 818. The end of the shaped channel 820 has an angled ramp 830. The open channel 822 extends from the open end 832 to a channel termination 834 near the opposite end of the body 818. The open channel 822 extends upward through the stem 824, the stop disk 826, and the rotation disk 828.

The lamp holder 810 also includes two vertical alignment grooves 836 that extend from the top of the stem 824 downward to the shaped channel 820. The lamp holder 810 also includes locking grooves 838 in the stop disk 826 that extend from the stem 824 to the outer edge of the stop disk 826.

The reflector 812 has an insertion end 840 with two insertion prongs 842. The reflector also has a semi-circular insertion hole 844 near the insertion end 840. The insertion hole 844 is used to mount the reflector 812 to the body 818, as described below.

The retention plug 814 includes a cap 846, a base 848, an insert arm 850, and a retaining arm 852. The base 848 includes two insert rails 854 that extend from the cap 846 to

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approximately midway down the base 848. The base 848 also includes an insert tab 882 on the side opposing the cap 846.

The insert arm 850 includes a retaining tab 856 that branches downward from the end of the insert arm 850. The retaining arm 852 includes two locking rails 858 that extend from the base 848 to the end of the retaining arm 852. Each locking rail 858 has a flat top edge and an angled bottom edge. The retaining arm 852 also includes a retaining tab 856 that branches downward from the end of the retaining arm 852.

Each contact clip 816 includes a tongue 860, a riser 862, contact fingers 868, and a coupling wall 870. The contact fingers 868 include angled portions 872 at the ends with a section of the contact finger 868 bent downward and another section of the contact finger 868 bent upward.

The wedge-base lamp holder 108 is assembled by inserting the contact fingers 868 on the contact clips 816 into the shaped channel 820. The tongues 860 are placed facing outward and resting in recesses 874 at the top of the stem 824. The reflectors 812 then are placed on top of the base 848 with the insertion ends 840 facing the center of the lamp holder 810. The insertion prongs 842 on the reflector 812 are slid into insertion grooves 876 (FIG. 29) located at the bottom of the stem 824 where the stem 824 meets the body 818.

Next, the retention plug 814 is inserted down into the body 818 with the insert arm 850 facing the channel termination 834 and the retention arm 852 facing the open end 832. The insert rails 854 on the retention plug 814 are aligned with and inserted into the alignment grooves 836 in the stem 824 of the body 818. Also, the retaining tabs 856 on the insert arm 850 and the retaining arm 852 of the retention plug 814 slide into the insertion holes 844 in the reflectors 812.

As illustrated in FIGS. 31 and 32, as the retention plug 814 slides downward into the holder 810, the locking rails 858 on the retention plug 814 lock into the locking grooves 838

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on the stop disk 826 and the insert tab or extension 882 on the base 848 fits into a notch or slot 880 in the bottom of the shaped channel 820. Inserting the extension 882 within the base slot 880 limits the movement of the retention plug 814 relative to the body 818.

The wedge-base lamp holder 108 is installed in the track network in a manner similar to that of the interface 103 shown in FIG. 9. The wedge-base lamp holder 108 is installed into the track network 101 with the cap 846 facing the track network 101 and is inserted into the opening 113. The tongues 860 of the contact clips 816 are placed in the lower channel 120 and the rotation disk 828 is placed in the upper channel 115. The stop disk 826 rests on the track frame 112 above the opening 113 to prevent over-insertion of the wedge-base lamp holder 108 in the track network 101. The wedge-base lamp holder 108 is rotated approximately 90 degrees relative to the track frame 112, tightly wedging the rotation disk 828 into the upper channel 115 and causing the tongues 860 of the contact clips 816 to make an electrical connection with the track network conductors 125.

VI. CONCISE STATEMENT OF THE ISSUES PRESENTED FOR REVIEW

The first issue in this appeal is whether claims 27 and 31 are unpatentable under 35 U.S.C. §102(b) over *Mouchi*. The second issue in this appeal is whether claims 27-42 are unpatentable under 35 U.S.C. §102(b) over *Glass*. The third issue in this appeal is whether claims 27-33 and 35-41 are unpatentable under 35 U.S.C. §102(b) over *Nieminen*. The fourth issue in this appeal is whether the specification provides clear support or antecedent basis for the claimed subject matter as required by 37 C.F.R. §1.75(d)(1).

The claims are divided into two (2) claim groupings as set out below. For the purposes of the argument set forth in the Appeal Brief, one claim from each group will be evaluated and discussed in connection with the prior art. The claim groups include:

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- (1) Claim Group I, which comprises claims 27 - 34; and
- (2) Claim Group II, which comprises claims 35 - 42.

Reasons That the Claim Groups Do Not Stand Or Fall Together

Although all claims of an application are independent or distinct, the Appellants have grouped the claims of the present application into two (2) claim groups. **One claim for each group has been chosen as the exemplary claim.** The reason that the chosen claim for any given group does not stand or fall with any claims of another group is, ultimately, because they are of differing scope. This differing scope is more specifically set out below.

In regard to Claim Group I, the exemplary independent claim 27 is broadly directed to a lamp holder for attaching to a track frame of a track lighting system. The lamp holder includes a base having a lamp channel for receiving a lamp. The lamp holder also includes an electrically conductive contact member. The electrically conductive contact member includes a first portion arranged in the lamp channel for contacting the lamp. The second portion of the electrically conductive contact member is for contacting an electrical conductor in the track frame. The lamp holder also includes a retention piece for securing the contact member within the base. If the Board of Patent Appeals determines that claim 27 defines over the cited art of record, then independent claim 27 and dependent claims 28-34 should be allowed independent of the treatment of the other claim groups.

In regard to Claim Group II, the exemplary independent claim 35 is set forth in means-plus-function format, and directed to a lamp holder attachable to a track frame of a track lighting system. The lamp holder includes a means, having a lamp channel, for receiving a lamp within the lamp channel. The lamp holder also includes a means for contacting the lamp in the lamp channel and for removably contacting an electrical conductor in the track frame. The lamp holder further includes a means for securing the contacting means within the receiving means.

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If the Board of Patent Appeals determines that independent claim 35 defines over the cited art of record, then independent claim 35 and dependent claims 36 – 42 should be allowed independent of the treatment of the other claim groups.

VII. ARGUMENT

Outline of Argument

- A. Framework for Discussion of the Rejections
 - 1. Fundamental Distinction of the Present Invention
 - 2. Discussion of Claim Language Reciting an Intended Use
- B. Discussion of Claim Group I
 - 1. Claim 27 is Patentable Over *Mouchie*
 - 2. Claim 27 is Patentable Over *Glass*
 - 3. Claim 27 is Patentable Over *Nieminen*
- C. Discussion of Claim Group II
 - 1. Claim 35 is Patentable Over *Glass*
 - 2. Claim 35 is Patentable Over *Nieminen*
- D. Discussion of the Objection to the Specification

A. Framework for the Discussion of the Rejections

Before addressing the specific claim rejections, the Appellants first set forth a general discussion to provide an understanding of the fundamental distinctions of the present invention from the cited references.

1. Fundamental Distinction of the Present Invention

As an initial matter, the rejections in the FINAL Office Action appear to indicate a fundamental misunderstanding of Appellants' claims 27 and 35 (the exemplary claims of Claim Group I and Claim Group II). Specifically, each of claims 27 and 35 are directed to “a **lamp holder**” for a track lighting system. For example, looking to the track lighting system of FIG. 1, several exemplary lamp holders are depicted as attached to track network 101. Exemplary lamp holder 108 (*see also* FIGs. 28-30) interfaces to track network 101, and also holds a lamp.

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In contrast, rather than directing Appellants attention to references directed to a lamp holder, each of the rejections in the FINAL Office Action direct Appellants attention to components of the track itself.

For example, in rejecting claims 27 and 35, the FINAL Office Action alleges that “*Mouchi* discloses a base 22 having a lamp channel for receiving a lamp.” (FINAL Office Action, pg. 2). However, *Mouchi* actually discloses a track 22. **Thus, the alleged “base” of *Mouchi* is not part of any lamp holder, but rather references the track itself.**

Additionally, in rejecting claims 27 and 35, the FINAL Office Action alleges that “*Glass* discloses a base 34 having a lamp channel for receiving a lamp.” (FINAL Office Action, pg. 3). However, *Glass* actually discloses a side wall 35 of a track. **Thus, the alleged “base” of *Glass* is not part of any lamp holder, but rather references the track itself.**

Finally, in rejecting claims 27 and 35, the FINAL Office Action alleges that “*Nieminen* discloses a base 22 having a lamp channel for receiving a lamp.” (FINAL Office Action, pg. 4). However, *Nieminen* actually discloses a track 22. **Thus, again the alleged “base” of *Nieminen* is not part of any lamp holder, but rather references the track itself.**

The terms of a preamble often put the body of the claims into context. As shown in FIG. 1 of Appellants’ application, and in each of the cited references, the lamps used in a track lighting system are not connected directly to the track itself, but rather are held by a lamp holder. Thus, the allegations presented in the FINAL Office Action, for example those that allege that the track itself is “capable of receiving a light,” are difficult to digest without any more specific factual or technical reasoning.

2. Discussion of Claim Language Reciting an Intended Use

The FINAL Office Action rejects claims 27 and 35 (the exemplary claims of Claim Group I and II) under 35 U.S.C. §102(b) as allegedly anticipated by *Mouchi*, *Glass*, or

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Nieminen. In each of these rejections, the FINAL Office Action alleges that these claims include “intended use” language that “has been given very little patentable weight.” (FINAL Office Action, pgs. 2-4) While each of claims 27 and 35 will be addressed specifically with respect to their respective claim groups, a general discussion of the proper interpretation of intended use and functional language is presented.

Regarding claim interpretation, Appellants respectfully assert that functional limitations in the claims cannot simply be ignored, but every limitation must be considered. See MPEP §2173.05(g). (“A functional limitation is an attempt to define something by what it does, rather than by what it is. Functional language does not, in and of itself, render a claim improper. A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it conveys to a person of ordinary skill in the pertinent art in the context in which it is used.”) See also *R.A.C.C. Industries v. Stun-Tech Inc.*, 49 USPQ2d 1793,1796-97 (Fed. Cir. 1998) (“adapted for concealment” interpreted as functional language requiring that an apparatus possess the capability of performing the recited function).

Further, the FINAL Office Action recites the following from MPEP 707.07(f):

“a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is *capable of performing the intended use*, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).”

(Emphasis added).

The Appellants assert that neither *Mouchi*, *Glass*, or *Nieminen* disclose the capability of performing the alleged “intended use” limitations recited in claims 27 and 35. An Advisory Action mailed October 20, 2003, apparently admits that certain limitations of claims 27 and 35 are not stated or implied by the references, but alleges that the limitations are not required to be disclosed by the references because these

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limitations allegedly recite an "intended use."

Specifically, the Advisory Action alleges that "the Examiner agrees it is not stated or implied by the references, but it doesn't have to be." (Advisory Action, pg. 2). Further, "the only test the Examiner has to meet is that the lamp channel of *Mouchi* or *Glass* is **capable of receiving a lamp.**" (*Emphasis Added*, Advisory Action, pg. 2). The Advisory Action concludes that "since the channel of *Mouchi* or *Glass* is clearly capable of receiving a lamp it reads on this limitation." (Advisory Action, pg. 2).

Neither the FINAL Office Action, or the ensuing Advisory Action, provide any basis in fact and/or technical reasoning to support the determination that *Mouchi*, *Glass*, or *Nieminen* is capable of performing the alleged "intended use" language recited in claims 27 and 35. Instead, the FINAL Office Action states a conclusory statement that "the channel of *Mouchi* or *Glass* is clearly capable of receiving a lamp" and "clearly the references of *Mouchi* or *Glass* or *Nieminen* meet this extremely broad interpretation." (Advisory Action, pg. 2). This is the sum total of the reasoning given in the FINAL Office Action and the ensuing Advisory Action as to why *Mouchi*, *Glass*, or *Nieminen* is capable of performing the alleged "intended use" language recited in claims 27 and 35.

Regardless of the insufficiency of the Office Action's *prime facie* case, Appellants assert that the language in claim 35 is not "intended use" language as alleged, but rather is clearly set forth in means-plus-function format, which must be analyzed in light of the corresponding structure disclosed in the specification and its equivalents. Further, in that the FINAL Office Action does not provide a basis in fact and/or specific technical reasoning to reasonably support the determination that *Mouchi*, *Glass*, or *Nieminen* are capable of performing the alleged "intended use"

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language, and for at least the additional reason that neither *Mouchi*, *Glass*, or *Nieminen* are capable of performing the recited language, Appellants believe the 102(b) rejection to Claim Group I and Claim Group II should be overturned. More specific detail as to the deficiencies of the rejections are set forth in the Discussion of Claim Group I and II below.

B. Discussion of Claim Group I

1. Claim 27 is Patentable Over *Mouchi*

The FINAL Office Action rejects independent claim 27 (the exemplary claim of Claim Group I) under 35 U.S.C. §102(b) as allegedly anticipated by *Mouchi*. However, in the present case, not every feature of the claimed invention is represented in *Mouchi*.

For example, *Mouchi* does not disclose “a base having **a lamp channel for receiving a lamp**” as recited in claim 27. The FINAL Office Action alleges that *Mouchi* discloses “a base 22 having a lamp channel for receiving a lamp.” (FINAL Office Action, pg. 2). However, *Mouchi* actually discloses a track 22 “with a longitudinal opening defined by lateral walls 28 and 28’.” (Col. 3, lines 43-44). *Mouchi* further discloses that the housing assembly 11 is “inserted into the longitudinal opening of track 22.” (Col. 5, lines 22-23). Thus, *Mouchi* does not disclose that the longitudinal opening receives a lamp.

Thus, *Mouchi* does not disclose, and the FINAL Office Action apparently does not even allege, that the longitudinal opening of track 22 actually receives a lamp. Rather, based on the Advisory Action of October 20, 2003, the FINAL Office Action apparently alleges that this feature is “intended use” language, and that the longitudinal opening of track 22 is equivalent to a lamp channel that is merely “**capable of receiving a lamp**.” (*Emphasis Added*, Advisory Action mailed Oct. 20, 2003, pg. 2). However, neither the FINAL Office Action, or the ensuing Advisory Action, provides any detail as to the reasoning for this entirely conclusory finding. The rejection should be overturned for this reason alone.

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Further, the Appellants submit that the “longitudinal opening” of track 22 is not physically capable of receiving a lamp as alleged by the FINAL Office Action. Neither the shape or the size of the longitudinal channel would allow such a capability. In fact, *Mouchi* discloses, at most, that track 22 is designed “to accommodate the insertion of the electrical connector 11.” (Col. 3, lines 42-43). Electrical connector 11 is nothing like a lamp. Thus, *Mouchi* apparently teaches away from the Office Action’s allegation.

Claim 27 defines over *Mouchi* for at least the additional reason that *Mouchi* does not disclose the additional feature of “an electrically conductive contact member having a first portion and a second portion, the first portion ***arranged in the lamp channel for contacting the lamp***” as recited in claim 27. The FINAL Office Action alleges that *Mouchi* discloses that an “electrically conductive contact member (8 and 9) has a first and second portion, the first portion of the contact member is arranged in the lamp channel for contacting the lamp.” (FINAL Office Action, pg. 2). However, *Mouchi* actually discloses that “contact member 9 remains in a fixed position and is so dimensioned and positioned so that said contact member will engage electrical conductor 25 after the housing 1 has been inserted in the longitudinal opening of said track 22.” (FIG. 3, Col. 4, lines 34-38). Additionally, *Mouchi* discloses that “contact member 8 is positioned to engage electrical conductor 24.” (Col. 4, lines 27-28).

Thus, *Mouchi* does not disclose, and the FINAL Office Action apparently does not even allege, that the portion of contact members 8 and 9 that are arranged in the track opening actually contact a lamp. Rather, The FINAL Office Action apparently alleges that this feature merely recites “intended use” language, and that the contact members 8 and 9 of *Mouchi* are equivalent to an electrically conductive contact member having a first portion and a second portion, the first portion arranged in the lamp channel wherein the first portion is “***capable of contacting the lamp***.” (*Emphasis Added*, Advisory Action mailed Oct. 20, 2003, pg. 2).

However, neither the FINAL Office Action, or the ensuing Advisory Action, provides any detail

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or sound technical reasoning as to this entirely conclusory finding. The rejection should be overturned for this reason alone.

Further, the Appellants submit that the first portion of contact members 8 and 9 is not capable of contacting a lamp as alleged by the FINAL Office Action. Specifically, with the first portion of the contact members in the track's opening, there is even less space in the track opening for receiving a lamp. Moreover, even assuming, *arguendo*, that track 22 is capable of receiving a lamp, the contact members 8 and 9 would not be capable of contacting the lamp. As shown in the sectional view of FIG. 3, contact members 8 and 9 contact electrical conductors 24 and 25 respectively. As shown, contact members 8 and 9 would not be physically accessible to also be "capable of contacting the lamp" without an undisclosed design metamorphosis. Since a lamp could not physically be received in *Mouchi*'s track opening, and contact members 8 and 9 would not be physically accessible to be capable of contacting a lamp in the channel, *Mouchi* fails to teach the claimed contact member that is both 1) "in the lamp channel" and 2) "for contacting a lamp" as recited in claim 27.

Thus, at a minimum, the rejection is improper for the reason that the required limitation of a "lamp channel for receiving a lamp" or "an electrically conductive contact member having a first portion and a second portion, the first portion ***arranged in the lamp channel for contacting the lamp***" is not disclosed by *Mouchi*. But even more, the rejection is improper for the reason that the alleged lamp channel of *Mouchi* is not even capable of receiving a lamp, and the alleged electrically conductive contact members in the lamp channel of *Mouchi* are not capable of contacting the lamp. Additionally, the determination in the FINAL Office Action that the alleged lamp channel is "capable of receiving a lamp" and that the first portion is "capable of contacting the lamp" is conclusory and without any factual or technical reasoning. Accordingly, and for at least these independent reasons, the Appellants respectfully submit that the FINAL Office Action rejection of claim 27 is legally insufficient,

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substantively misplaced, and should be overturned.

2. Claim 27 is Patentable Over Glass

The FINAL Office Action rejects independent claim 27 (the exemplary claim of Claim Group I) under 35 U.S.C. §102(b) as allegedly anticipated by *Glass*. However, in the present case, not every feature of the claimed invention is represented in *Glass*.

For example, *Glass* does not disclose, either explicitly or implicitly, the feature of “a base having **a lamp channel for receiving a lamp**” as recited in claim 27. The FINAL Office Action alleges that *Glass* discloses “a base 34 having a lamp channel for receiving a lamp.” (FINAL Office Action, pg. 3). However, *Glass* actually discloses a track “comprised of an elongated housing 24” (FIG. 4, Col. 3, line 48), and that “formed within the housing is a T-shaped channel which includes the transverse slot 26 bounded by the upper wall 28, the lower wall 30 and the two angled side walls 32 and 34.” (FIG. 4, col. 3, lines 50-53). Further, *Glass* discloses that a “cross bar is inserted in the open groove as shown in the dotted line 92 in FIG. 4.” (Col. 4, lines 64-66). Accordingly, instead of receiving a lamp, *Glass* discloses that the channel receives a cross bar 56.

Thus, *Glass* does not disclose, and the FINAL Office Action apparently does not even allege, that the T-shaped channel actually receives a lamp. Rather, based on the Advisory Action of October 20, 2003, the FINAL Office Action apparently alleges that this feature merely recites “intended use” language, and that the T-shaped channel of the track is equivalent to a lamp channel that is “**capable of receiving a lamp**.” (*Emphasis Added*, Advisory Action, pg. 2). However, neither the FINAL Office Action, or the ensuing Advisory Action, provides any detail as to the reasoning for this entirely conclusory finding. The rejection should be overturned for this reason alone.

Further, the Appellants submit that the T-shaped channel is not physically capable of receiving a lamp as alleged by the FINAL Office Action. Neither the shape or the size of the T-

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shaped channel would allow such a capability. In fact, *Glass* discloses, at most, that the T-shaped channel receives a cross bar 56. Cross bar 56 is nothing like a lamp. Thus, *Glass* apparently teaches away from the Office Action's allegation.

Claim 27 defines over *Glass* for at least the additional reason that *Glass* does not disclose the additional feature of "an electrically conductive contact member having a first portion and a second portion, the first portion ***arranged in the lamp channel for contacting the lamp***" as recited in claim 27. The FINAL Office Action alleges *Glass* discloses that an "electrically conductive contact member (62 and 64) has a first and second portion, the first portion of the contact member is arranged in the lamp channel for contacting the lamp." (FINAL Office Action, pg. 2). However, *Glass* actually discloses that "a pair of conical contacts 58, 60 depend from the cross bar." (Col. 4, lines 10-11), and "the contacts extend through the cross bar having their tops countersunk into the upper surface of the cross bar." (Col. 4, lines 11-13). Finally, *Glass* discloses that "the contact holes can receive the respectively insulated wires 62, 64." (Col. 4, lines 14-15). Thus, *Glass* does not disclose that the first portions of wires 62 and 64, arranged in the channel, contact a lamp. Rather, the portions of wires 62 and 64 are used to contact conical contacts 58 and 60.

Thus, *Glass* does not disclose, and the FINAL Office Action apparently does not even allege, that the portion of insulated wires 62 and 64 that are arranged in the track opening actually contact a lamp. Rather, the FINAL Office Action apparently alleges that this feature merely recites "intended use" language, and that the wires 62 and 64 of *Glass* are equivalent to an electrically conductive contact member having a first portion and a second portion, the first portion arranged in the lamp channel wherein "the first portion is ***capable of contacting the lamp***." (*Emphasis Added*, Advisory Action mailed Oct. 20, 2003, pg. 2). However, neither the FINAL Office Action, or the ensuing Advisory Action, provides any detail or sound technical

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reasoning as to this entirely conclusory finding. The rejection should be overturned for this reason alone.

Moreover, even assuming, *arguendo*, that the T-shaped channel is capable of receiving a lamp, the insulated wires 62 and 64 would not be capable of contacting the lamp. As shown in the sectional view of FIG. 2, insulated wires 62 and 64 conical contacts 58 and 60 (FIG. 4) respectively. With the first portion of the insulated wires 62 and 64 in the T-shaped channel, there is even less space in the T-shaped channel for receiving a lamp. As shown, wires 62 and 64 would not be physically accessible to also be "capable of contacting the lamp" without an undisclosed design metamorphosis.

In fact, *Glass* discloses that wires 62 and 64 are "insulated from each other as well as the conical contact which are insulated from each other." (Col. 4, lines 17-19). Additionally, "the cross bar itself can be made of insulating material as can the entire contacting member 44." (Col. 4, lines 19-20). Thus, with nearly every component in the T-shaped channel "insulated," including insulated wires 62 and 64, Appellants are hardly convinced that *Glass* "clearly" discloses that the insulated wires 62 and 64 "are capable of contacting the lamp" as alleged (Advisory Action, pg. 2).

Since a lamp could not physically be received in the T-shaped channel of *Glass*, and wires 62 and 64 would not be capable of contacting a lamp in the channel, *Glass* fails to disclose that the claimed contact member that is both 1) "in the lamp channel" and 2) "for contacting a lamp" as recited in claim 27.

Thus, at a minimum, the rejection is improper for the reason that the required limitation of a "lamp channel for receiving a lamp" or "an electrically conductive contact member having a first portion and a second portion, the first portion ***arranged in the lamp channel for contacting the lamp***" is not disclosed by *Glass*. But even more, the rejection is improper for the reason that the alleged lamp channel of *Glass* is not even capable of

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receiving a lamp, and the alleged electrically conductive contact members in the lamp channel of *Glass* are not capable of contacting the lamp. Additionally, the determination in the FINAL Office Action that the alleged lamp channel is "capable of receiving a lamp" and that the first portion is "capable of contacting the lamp" is conclusory and without any factual or technical reasoning. Accordingly, and for at least these independent reasons, the Appellants respectfully submit that the FINAL Office Action rejection of claim 27 is legally insufficient, substantively misplaced, and should be overturned.

3. Claim 27 is Patentable Over *Nieminen*

The FINAL Office Action rejects independent claim 27 (the exemplary claim of Claim Group I) under 35 U.S.C. §102(b) as allegedly anticipated by *Nieminen*. However, in the present case, not every feature of the claimed invention is represented in *Nieminen*.

For example, *Nieminen* does not disclose "a base having **a lamp channel for receiving a lamp**" as recited in claim 27. The FINAL Office Action alleges that *Nieminen* discloses "a base 22 having a lamp channel for receiving a lamp." (FINAL Office Action, pg. 4). However, *Nieminen* actually discloses "a dual-circuit track with which the track adapter of FIG. 1 is adapted for use." (Col. 2, lines 53 – 54). Specifically, "the track 22 has first and second side walls 23,24, a top wall 25, and a bottom wall 26 defining a hollow longitudinal passageway 28." (Col. 4, lines 10-12). Accordingly, track 22 includes a hollow longitudinal passageway 28 which apparently receives the adapter depicted in FIG. 1. Thus, *Nieminen* does not disclose that the hollow longitudinal passageway receives a lamp.

Thus, *Nieminen* does not disclose, *and the FINAL Office Action apparently does not even allege*, that the longitudinal channel actually receives a lamp. Rather, based on the Advisory Action of October 20, 2003, the FINAL Office Action apparently alleges that this feature merely recites "intended use" language, and that the longitudinal channel of the track is equivalent to a lamp channel that is "**capable of receiving a lamp**." (*Emphasis Added*,

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Advisory Action, pg. 2). However, neither the FINAL Office Action, or the ensuing Advisory Action, provides any detail as to the reasoning for this entirely conclusory finding. The rejection should be overturned for this reason alone.

Further, the Appellants submit that the longitudinal channel is not physically capable of receiving a lamp as alleged by the FINAL Office Action. Neither the shape or the size of the longitudinal channel would allow such a capability. In fact, *Nieminen* discloses, at most, that the track 22 includes a hollow longitudinal passageway 28 which apparently receives the adapter depicted in FIG. 1. The adapter in FIG. 1 is nothing like a lamp. Thus, *Nieminen* apparently teaches away from the Office Action's allegation.

Claim 27 defines over *Nieminen* for at least the additional reason that *Nieminen* does not disclose the additional feature of "an electrically conductive contact member having a first portion and a second portion, the first portion ***arranged in the lamp channel for contacting the lamp***" as recited in claim 27. The FINAL Office Action alleges *Nieminen* discloses that an "electrically conductive contact member (16 and 20) has a first and second portion, the first portion of the contact member is arranged in the lamp channel for contacting the lamp." (FINAL Office Action, pg. 4). However, *Nieminen* actually discloses that "the end of the neutral contact 16 engages the neutral bus 37, and the end of the ground contact 18 engages the grounding rib 29." (FIG. 36, col. 7, lines 59-61). Thus, *Nieminen* does not disclose that the first portions of neutral contact 16 and ground contact 18, that are arranged in the channel, contact a lamp. Rather, the portions of neutral contact 16 and ground contact 18 are used to contact the neutral bus 37 and the grounding rib 29, respectively.

Thus, *Nieminen* does not disclose, and the FINAL Office Action apparently does not even allege, that the portion of neutral contact 16 and ground contact 18 that are arranged in the track opening actually contact a lamp. Rather, The FINAL Office Action apparently alleges that this feature merely recites "intended use" language, and that neutral contact 16 and ground

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contact 18 of *Nieminen* are equivalent to an electrically conductive contact member having a first portion and a second portion, the first portion arranged in the lamp channel and “the first portion is ***capable of contacting the lamp***.” (*Emphasis Added*, Advisory Action, pg. 2).

However, neither the FINAL Office Action, or the ensuing Advisory Action, provides any detail or sound technical reasoning as to this entirely conclusory finding. The rejection should be overturned for this reason alone.

Further, the Appellants submit that the alleged first portion of neutral contact 16 and ground contact 18 are not capable of contacting a lamp as alleged by the FINAL Office Action. Specifically, with the first portion of neutral contact 16 and ground contact 18 in the longitudinal channel, there is even less space in the longitudinal channel for receiving a lamp. Moreover, even assuming, *arguendo*, that the longitudinal channel is capable of receiving a lamp, the neutral contact 16 and ground contact 18 would not be capable of contacting the lamp. As shown in the sectional view of FIGs. 36 and 37, neutral contact 16 and ground contact 18 would not be physically accessible to be “capable of contacting the lamp” without an undisclosed design metamorphosis.

Because a lamp could not physically be received in the longitudinal channel of *Nieminen*, and neutral contact 16 and ground contact 18 would not be capable of contacting a lamp in the channel, *Nieminen* fails to disclose the claimed contact member that is both 1) “in the lamp channel” and 2) “for contacting a lamp” as recited in claim 27.

Thus, at a minimum, the rejection is improper for the reason that the required limitation of a “lamp channel for receiving a lamp” or “an electrically conductive contact member having a first portion and a second portion, the first portion ***arranged in the lamp channel for contacting the lamp***” is not disclosed by *Nieminen*. But even more, the rejection is improper for the reason that the alleged lamp channel of *Nieminen* is not even capable of receiving a lamp, and the alleged electrically conductive contact members in the lamp channel

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of *Nieminen* are not capable of contacting the lamp. Additionally, the determination in the FINAL Office Action that the alleged lamp channel is "capable of receiving a lamp" and that the first portion is "capable of contacting the lamp" is conclusory and without any factual or technical reasoning. Accordingly, and for at least these independent reasons, the Appellants respectfully submit that the FINAL Office Action rejection of claim 27 is legally insufficient, substantively misplaced, and should be overturned.

C. Discussion of Claim Group II

1. Claim 35 is Patentable Over *Glass*

The FINAL Office Action rejects independent claim 35 (the exemplary claim of Claim Group II) under 35 U.S.C. §102(b) as allegedly anticipated by *Glass*. However, in the present case, not every feature of the claimed invention is represented in *Glass*.

As an initial matter, the FINAL Office Action rejects independent claims 27 and 35 on an identical basis. The Appellants respectfully submit that the scope of these claims are not co-extensive. In particular, the Appellants respectfully point out that claim 35 is set forth in means plus function format and thus should be analyzed in light of the corresponding structure disclosed in the specification and its equivalents. *Notwithstanding, the FINAL Office Action failed to differentiate the elements in this way.* Hence, the Appellants respectfully submit that the Office Action improperly rejects claims 27 and 35 as a group without individually considering each and every element of claim 35. This reflects legal error, and the rejection should be overturned for this reason alone.

In addition, the corresponding structure disclosed in the present specification that corresponds to the various means elements is distinct from that disclosed in the cited patents. For at least this additional reason, Appellants submit that the rejection of claim 35 should be overturned, as claim 35 patently defines over the cited patents.

For example, *Glass* does not disclose a "*means, having a lamp channel, for*

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receiving a lamp within the lamp channel” as recited in claim 35. The FINAL Office Action does not specifically address this claim, but rather alleges that *Glass* discloses “a base 34 having a lamp channel for receiving a lamp.” (FINAL Office Action, pg. 3). However, the alleged structure does not correspond to a “*means, having a lamp channel, for receiving a lamp within the lamp channel*” as recited in claim 35. Rather, *Glass* actually discloses a track “comprised of an elongated housing 24” (FIG. 4, Col. 3, line 48), and that “formed within the housing is a T-shaped channel which includes the transverse slot 26 bounded by the upper wall 28, the lower wall 30 and the two angled side walls 32 and 34.” (FIG. 4, col. 3, lines 50-53). Further, *Glass* discloses, a “cross bar is inserted in the open groove as shown in the dotted line 92 in FIG. 4.” (Col. 4, lines 64-66). Instead of receiving a lamp, *Glass*’s channel receives a cross bar 56. Accordingly, *Glass* does not disclose a “*means, having a lamp channel, for receiving a lamp within the lamp channel.*”

The FINAL Office Action apparently alleges that this feature merely recites “intended use” language, and therefore it is enough that the T-shaped channel of the track is equivalent to a lamp channel that is merely “*capable of receiving a lamp.*” (*Emphasis Added*, Advisory Action mailed Oct. 20, 2003, pg. 2). Appellants assert that, as applied to claim 35, this rejection is improper. Rather, the recited “means” element **must be construed in accordance with the structure set forth in the present specification.** See *In re Donaldson* 16 F.3d 1189, 29 U.S.P.Q.2d 1845 (Fed. Cir. 1994)(*en banc*).

Even assuming *arguendo* that the rejection is proper, Appellants submit that the alleged T-shaped channel is not physically capable of receiving a lamp as alleged by the FINAL Office Action. Neither the shape or the size of the T-shaped channel would allow such a capability.

Claim 35 defines over *Glass* for at least the additional reason that *Glass* does not disclose the additional feature of a “*means for contacting the lamp in the lamp channel and*

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for removeably contacting an electrical conductor in the track frame” as recited in claim

35. The FINAL Office Action alleges *Glass* discloses that an “electrically conductive contact member (62 and 64) has a first and second portion, the first portion of the contact member is arranged in the lamp channel for contacting the lamp.” (FINAL Office Action, pg. 2).

However, *Glass* actually discloses that “a pair of conical contacts 58, 60 depend from the cross bar” (Col. 4, lines 10-11), and “the contacts extend through the cross bar having their tops countersunk into the upper surface of the cross bar.” (Col. 4, lines 11-13). Finally, *Glass* discloses that “the contact holes can receive the respectively insulated wires 62, 64.” (Col. 4, lines 14-15). Thus, *Glass* does not disclose that the first portions of wires 62 and 64, arranged in the channel, contact a lamp. Rather, the portions of wires 62 and 64 are used to contact conical contacts 58 and 60. Thus, *Glass* does not disclose a ***“means for contacting the lamp in the lamp channel and for removeably contacting an electrical conductor in the track frame”*** as recited in claim 35.

The FINAL Office Action apparently alleges that this feature merely recites “intended use” language, and therefore it is enough that the wires 62 and 64 of *Glass* are equivalent to an electrically conductive contact member having a first portion and a second portion, the first portion arranged in the lamp channel and the first portion is merely ***“capable of contacting the lamp.”*** (*Emphasis Added*, Advisory Action mailed Oct. 20, 2003, pg. 2). Appellants assert that, as applied to claim 35, this rejection is improper. Rather, the recited “means” element **must be construed in accordance with the structure set forth in the present specification.** See *In re Donaldson* 16 F.3d 1189, 29 U.S.P.Q.2d 1845 (Fed. Cir. 1994)(*en banc*).

Even assuming, *arguendo*, that the rejection is proper, Appellants submit that the alleged first portion of insulated wires 62 and 64 are not capable of contacting a lamp as alleged by the FINAL Office Action. Specifically, with the first portion of the insulated wires 62 and 64

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in the T-shaped channel, there is even less space in the T-shaped channel for receiving a lamp. As shown in the sectional view of FIG. 2, insulated wires 62 and 64 conical contacts 58 and 60 (FIG. 4) respectively. As shown, wires 62 and 64 would not be physically accessible to also be "capable of contacting the lamp" without an undisclosed design metamorphosis.

In fact, *Glass* discloses that wires 62 and 64 are "insulated from each other as well as the conical contact which are insulated from each other." (Col. 4, lines 17-19). Additionally, "the cross bar itself can be made of insulating material as can the entire contacting member 44." (Col. 4, lines 19-20). Thus, with nearly every component in the T-shaped channel "insulated," including insulated wires 62 and 64, Appellants are hardly convinced that *Glass* "clearly" discloses that the insulated wires 62 and 64 "are capable of contacting the lamp" as alleged (Advisory Action, pg. 2).

Since a lamp could not physically be received in the T-shaped channel of *Glass*, and wires 62 and 64 would not be capable of contacting a lamp in the channel, *Glass* fails to disclose that the claimed contact member that is both 1) "in the lamp channel" and 2) "for contacting a lamp" as recited in claim 35.

Thus, at a minimum, the rejection is improper for the reason that the required limitation of a "***means, having a lamp channel, for receiving a lamp within the lamp channel***" or "***means for contacting the lamp in the lamp channel and for removeably contacting an electrical conductor in the track frame***" is not disclosed by *Glass*. But even more, the rejection is improper for the reason that the alleged lamp channel of *Glass* is not even capable of receiving a lamp, and the alleged electrically conductive contact members in the lamp channel of *Glass* are not capable of contacting the lamp. Accordingly, and for at least these reasons, the Appellants respectfully submit that the FINAL Office Action rejection of claim 35 is legally insufficient, substantively misplaced, and should be overturned.

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2. Claim 35 is Patentable Over *Niemenen*

The FINAL Office Action rejects independent claim 35 (the exemplary claim of Claim Group II) under 35 U.S.C. §102(b) as allegedly anticipated by *Niemenen*. However, in the present case, not every feature of the claimed invention is represented in *Niemenen*.

Once again, the FINAL Office Action rejects independent claims 27 and 35 on an identical basis. The Appellants respectfully submit that the scope of these claims are not co-extensive. In particular, the Appellants respectfully point out that claim 35 is set forth in means plus function format and thus should be analyzed in light of the corresponding structure disclosed in the specification and its equivalents. *Notwithstanding, the FINAL Office Action, failed to differentiate the elements in this way.* Hence, the Appellants respectfully submit that the Office Action improperly rejects claims 27 and 35 as a group without individually considering each and every element of claim 35. This reflects legal error, and the rejection should be overturned for this reason alone.

In addition, the corresponding structure disclosed in the present specification that corresponds to the various means elements is distinct from that disclosed in the cited patents. For at least this additional reason, Appellants submit that the rejection of claim 35 should be overturned, as claim 35 patently defines over the cited patents.

For example, *Niemenen* does not disclose a “**means, having a lamp channel, for receiving a lamp within the lamp channel**” as recited in claim 35. The FINAL Office Action alleges that *Niemenen* discloses “a base 22 having a lamp channel for receiving a lamp.” (FINAL Office Action, pg. 4). However, *Niemenen* actually discloses “a dual-circuit track with which the track adapter of FIG. 1 is adapted for use.” (Col. 2, lines 53 – 54). Specifically, “the track 22 has first and second side walls 23,24, a top wall 25, and a bottom wall 26 defining a hollow longitudinal passageway 28.” (Col. 4, lines 10-12). Thus track 22 includes a hollow longitudinal passageway 28 which apparently receives the adapter depicted

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in FIG. 1. A hollow longitudinal passageway which receives an "adaptor" is not the equivalent of a **"means, having a lamp channel, for receiving a lamp within the lamp channel"** as recited by claim 35. Thus, *Nieminen* does not disclose a "means, having a lamp channel, for receiving a lamp within the lamp channel" as recited in claim 35.

The FINAL Office Action apparently alleges that this feature merely recites "intended use" language, and therefore it is enough that the longitudinal channel of the track is equivalent to a lamp channel that is **"capable of receiving a lamp."** (*Emphasis Added*, Advisory Action mailed Oct. 20, 2003, pg. 2). (*Emphasis Added*, Advisory Action mailed Oct. 20, 2003, pg. 2). Appellants assert that, as applied to claim 35, this rejection is improper. Rather, the recited "means" element **must be construed in accordance with the structure set forth in the present specification.** See *In re Donaldson* 16 F.3d 1189, 29 U.S.P.Q.2d 1845 (Fed. Cir. 1994)(*en banc*).

Even assuming *arguendo*, that the rejection is proper the Appellants submit that the alleged first portion of neutral contact 16 and ground contact 18 are not capable of contacting a lamp as alleged by the FINAL Office Action. Specifically, with the first portion of neutral contact 16 and ground contact 18 in the longitudinal channel, there is even less space in the longitudinal channel for receiving a lamp. Moreover, even assuming, *arguendo*, that the longitudinal channel is capable of receiving a lamp, the neutral contact 16 and ground contact 18 would not be capable of contacting the lamp. As shown in the sectional view of FIGs. 36 and 37, neutral contact 16 and ground contact 18 would not be physically accessible to be "capable of contacting the lamp" without an undisclosed design metamorphosis.

Claim 35 defines over *Nieminen* for at least the additional reason that *Nieminen* does not disclose the additional feature of **"means for contacting the lamp in the lamp channel and for removeably contacting an electrical conductor in the track frame"** as recited in claim 35. The FINAL Office Action alleges *Nieminen* discloses that an "electrically conductive contact

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member (16 and 20) has a first and second portion, the first portion of the contact member is arranged in the lamp channel for contacting the lamp.” (FINAL Office Action, pg. 4). However, *Nieminen* actually discloses that “the end of the neutral contact 16 engages the neutral bus 37, and the end of the ground contact 18 engages the grounding rib 29.” (FIG. 36, col. 7, lines 59-61). The portions of neutral contact 16 and ground contact 18 are not used to contact the lamp, but rather are used to contact the neutral bus 37 and the grounding rib 29, respectively. Thus, *Nieminen* does not disclose a “**means for contacting the lamp in the lamp channel and for removeably contacting an electrical conductor in the track frame**” as recited by claim 35.

The FINAL Office Action apparently alleges that this feature merely recites “intended use” language, and therefore it is enough that neutral contact 16 and ground contact 18 of *Nieminen* are equivalent to an electrically conductive contact member having a first portion and a second portion, the first portion arranged in the lamp channel and the first portion is merely “**capable of contacting the lamp.**” (*Emphasis Added*, Advisory Action mailed Oct. 20, 2003, pg. 2). Appellants assert that, as applied to claim 35, this rejection is improper. Rather, the recited “means” element **must be construed in accordance with the structure set forth in the present specification.** See *In re Donaldson* 16 F.3d 1189, 29 U.S.P.Q.2d 1845 (Fed. Cir. 1994)(*en banc*).

Further, even assuming, *arguendo*, that the rejection is proper, the Appellants submit that the alleged first portion of neutral contact 16 and ground contact 18 are not capable of contacting a lamp as alleged by the FINAL Office Action. Specifically, with the first portion of neutral contact 16 and ground contact 18 in the longitudinal channel, there is even less space in the longitudinal channel for receiving a lamp. Moreover, even assuming, *arguendo*, that the longitudinal channel is capable of receiving a lamp, the neutral contact 16 and ground contact 18 would not be capable of contacting the lamp. As shown in the sectional view of FIGs. 36

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and 37, neutral contact 16 and ground contact 18 would not be physically accessible to be “capable of contacting the lamp” without an undisclosed design metamorphosis.

Thus, at a minimum, the rejection is improper for the reason that the required limitation of a “*means, having a lamp channel, for receiving a lamp within the lamp channel*” or a “*means for contacting the lamp in the lamp channel and for removeably contacting an electrical conductor in the track frame*” is not disclosed by *Nieminen*. But even more, the rejection is improper for the reason that the alleged lamp channel of *Nieminen* is not even capable of receiving a lamp, and the alleged electrically conductive contact members in the lamp channel of *Nieminen* are not capable of contacting the lamp. Additionally, the FINAL Office Action’s determination that the alleged lamp channel is “capable of receiving a lamp” and that the first portion is “capable of contacting the lamp” is conclusory and without any factual or technical reasoning. Accordingly, and for at least these reasons, the Appellants respectfully submit that the FINAL Office Action rejection of claim 35 is legally insufficient, substantively misplaced, and should be overturned.

D. Discussion of the Objection to the Specification

The FINAL Office Action objected to the specification as failing to provide proper antecedent basis for the subject matter of claim 27 as required under 37 CFR §1.75(d)(1). Appellants respectfully traverse this objection and assert that the terms and phrases of claim 27 “find clear support or antecedent basis” in the description so that the meaning of the terms in the claims are ascertainable by reference to the description as required by 37 CFR §1.75(d)(1).

For example, Figs. 28-32 illustrate an embodiment, which is described in detail in the Summary section and on p. 22, line 1 through p. 24, line 12 of the substitute specification that was filed on October 16, 2002. This particular embodiment includes a body 818, shown in Fig. 30, generally forming a base. A shaped channel 820 generally forms a lamp channel. Contact clips 816 generally form contact members, in which contact fingers 868 generally form a first

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portion of the contact clips and a tongue 860 generally forms a second portion of the contact clips. A retention plug 814 generally forms a retention piece. Appellants submit that the above features provide clear support or antecedent basis for the terms and phrases of claim 27 and respectfully request that the objections to the specification be overruled.

Assuming, *arguendo*, that the terms and phrases used in claim 27 do not find "clear support or antecedent basis" in the specification, the Appellants agreed to provide appropriate amendments to the specification in Appellants' "Request for Reconsideration" of September 30, 2003. No mention of the objection to the specification was received in the resulting Advisory Action mailed October 20, 2003.

The FINAL Office Action does not include a rejection under 35 U.S.C. §112, first paragraph. Thus, the language of claim 27 is fully supported by the description of the invention in the application as filed. Accordingly, Appellants remain willing to amend the specification, or agree to a telephonic interview to further link each element recited in claim 27 to the location where each feature finds clear support or antecedent basis in the description and drawings.

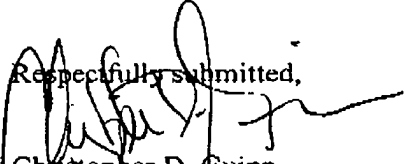
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VIII. CONCLUSION

Based upon the foregoing discussion, Appellants respectfully assert that the FINAL Office Action's final rejection of claims 27-42 is improper. Appellants respectfully request that the rejections be overruled and overturned by the Board, and that the application be allowed to issue as a patent with all pending claims.

Please charge deposit account no. 20-0778 in the amount of \$330 for the filing of this Appeal Brief. No additional fees are believed to be due in connection with this Appeal Brief. If, however, any additional fees are deemed to be payable, you are hereby authorized to charge any such fees to deposit account no. 20-0778.

Respectfully submitted,


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